



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/392,934 10/28/96 SMITH

R 01-3033

EXAMINER

HM22/1027

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LOS ANGELES CA 90067-4164

SCHWADRON, R

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/392,934

Applicant(s)

Smith et al.

Examiner

Ron Schwadron, Ph.D.

Group Art Unit

1644



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above, claim(s) 2-30, 32, 33, and 35 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1, 31, 34, and 36 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1644

1. **Please note.** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at Paula.Hutzell @ uspto.gov or (703) 308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Applicant's election with traverse Group I, claims 1,31,34 and 36 in Paper No.31 is acknowledged. The traversal is on the ground(s) that are stated in said paper. This is not found persuasive because of the following reasons. Regarding applicants arguments, the PTO currently interprets "consisting essentially" as recited in the instant claims as encompassing the intact protein from which the peptide recited in the claims was derived. Said molecule was known in the art. In addition, the claims encompass the fourth peptide recited in the claims with any five amino acids attached to the N-terminal end. The antibodies of Group III bind said peptide. However, said antibodies are known in the art. Sculley et al. (WO 91/08224, cited on IDS enclosed with the instant application) teaches the peptide epitope AHARDK and antibodies which bind said epitope (see entire document). Said epitope is encompassed by the fourth peptide recited in the claims (eg. any five amino acids attached to K at N-terminal). Therefore, the antibodies taught by Sculley et al. anticipate the invention of Group III. Therefore, the technical feature linking the inventions of Groups I-VII does not constitute a special technical feature as defined by PCT rule 13.2, as it does not define a contribution over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 2-30,32,33,35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected ^{inventions} species, the requirement having been traversed in Paper No. 31.

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4. Claims 1,31,34 and 36 are generic to a plurality of disclosed patentably distinct species comprising the four different peptides recited in claim 1. Applicant is required to elect one of said four peptides.

These peptides have different amino acid sequences.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Tuesday through Friday from 8:30 to 6:00. The examiner can also be reached on alternative Mondays. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

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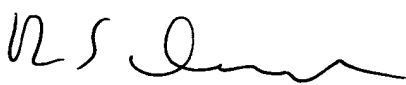
Art Unit: 1644

Ron Schwadron, Ph.D.

Primary Examiner

Art Unit 1644

October 25, 1999


RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800-1600



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

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IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

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